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10/627,413	07/25/2003	Arthur M. Krieg	C1039,70079US00	3204
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/627,413

Applicant(s)

KRIEG ET AL.

Examiner

EMILY M. LE

Art Unit

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/30/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-74 is/are pending in the application.
- 4a) Of the above claim(s) 44-46, 52-54 and 59-61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42, 43, 47-51, 55-58 and 62-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/30/2008 has been entered.

Status of Claims

2. Claims 1-41 are cancelled. Claims 72-74 are added. Claims 42-74 are pending. Claims 44-46, 52-54 and 59-61 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 08/04/2006. Claims 42-43, 47-51, 55-58 and 62-74 are under examination.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 42-43, 47-51, 55-58 and 62-74 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable

one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In response to the enablement rejection, Applicant continues to argue that the claimed invention is enabling. To support Applicant's argument, Applicant argues that Applicant teaches that CpG oligonucleotides are a class of therapeutic agents that induce immune response capable of treating an infectious disease. Applicant submits that at the time the invention was made, the skilled artisan would have known and understood that CpG oligonucleotides were useful in the treatment of infectious diseases, including viral infections.

Applicant's argument has been considered, however, it is not found persuasive. While Applicant may teach that CpG oligonucleotides are immunostimulatory and suggests the use of the immunostimulatory activities to treat infections, Applicant failed short of enabling the skilled artisan how to harness the activities to render it therapeutic.

In addition to above, Applicant criticizes the Office for noting that it is known in the art that CpG oligonucleotides induce a Th1 biased immune response. Applicant argues that it was not known in the prior art that these oligonucleotides induce a Th1 biased immune response, and that such discovery is part of Applicant's invention. Applicant also criticizes the arts cited by the Office to support the enablement rejection. For instance, Applicant argues that Infante-Duarte et al. was published several years after Applicant's priority date.

In response to Applicant's criticisms, it should be noted that the language used by the Office is "known in the art". In the instant case, the Office is not asserting that the

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immunostimulatory activities, a Th1 biased immune response induced by the oligonucleotides are known prior to the filing of the claimed invention. The statement is directed at the general knowledge of the CpG art, that the CpG containing oligonucleotides are immunostimulatory. This statement was used to demonstrate that in the years following the discovery that CpG oligonucleotides are immunostimulatory, the CpG art has not been able to harness such activity to render it therapeutic in the treatment of infections. Regarding the teachings of Infante-Duarte et al., Applicant is correct to note that the reference has a publication date that is after Applicant's filing. However, Applicant is reminded that this is not a prior art rejection. It is neither an anticipatory nor an obviousness rejection. In an enablement rejection, the use of arts, either prior to or after the filing of Applicant's invention is applicable to demonstrate the state of the art. In the instant case, the art evidences that the use of the immune response induced by CpG oligonucleotides to treat infections is unpredictable and that undue experimentation would be imparted onto the skilled artisan attempting to practice the claimed invention.

Applicant also takes issue with the Office when it notes that the statement "At the time the invention was made, it is well known in the art that the CpG motif present in the oligonucleotide stimulates Th1 immune response..." was not provided in the "instant nor previous office action." (03/31/08 and 06/28/07 office actions) Applicant argues that contrary to the Office's assertion, such statement was present on page 4 of the 03/31/08 and page 11 of the 06/28/07 office actions.

Applicant's argument has been considered. The Office stands corrected, such statement can only be found in the 06/28/2007 office action. Contrary to Applicant's assertion, the Office did not state that "At the time the invention, was made, it is well know in the art that the CpG motif present in the oligonucleotide stimulates Th1 immune response" at page 4 of the previous office action. At page 4 of the office action, the Office writes, "As provided in the previous office actions, it is known in the art that these oligonucleotides induce a Th1 biased immune response". This is different from alleging that immune stimulation properties of CpG oligonucleotides are known at the time the invention was made.

Applicant additionally revisits the teachings of Poetker et al. Applicant argues that Poetker et al. evidences that CpG oligonucleotides has important impact on papilloma virus infection in vivo, and that the finding that CpG oligonucleotide had no effect on papilloma growth does not support the finding that CpG oligonucleotides are not useful in treating papilloma virus infection.

Applicant's argument has been considered, however, it is not found persuasive. One scope of the claimed invention is the prevention of papilloma viral infection. Poetker et al. clearly evidences that CpG oligonucleotide failed to prevent such infection. That is, this scope of the claimed invention is not enabling in view of the teachings of the art. Additionally, Poetker et al. clearly notes that the "study failed to demonstrate any therapeutic effect of CpG ODN on papilloma growth in a rabbit model." [First sentence, Discussion section, page 660, in particular.] Moreover, Poetker et al. also outlines the difficulties in treating papillomas. Poetker et al. notes that there is a

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tumor size threshold, if surpassed, prevents the CpG oligonucleotide from eliciting an immune response strong enough to affect tumors. Poetker et al. also notes that timing of treatment is also of significance relevance when Poetker et al. discloses that "had we known that the tumors were capable of such exponential growth, treatments would have begun well before..." It should be noted that the Office cited Poetker et al. to demonstrate that the use of CpG oligonucleotides to treat papilloma viral infection has yet to be ascertained in the art and significant investigation has to be undertaken before such treatment can be ascertained. Combined with the other challenges that the skilled artisan would encounter in attempting to practice the claimed invention, would imposed the burden of undue experimentation on said skilled artisan.

In response to the Office's position that Applicant has failed to set forth any guidance as to the type and level of immune profile that oligonucleotides must ascertain in order to render it therapeutically effective, Applicant argues that the skilled artisan would be able to ascertain the necessary data with routine experimentation.

Applicant's argument has been considered, however, it is not found persuasive. As discussed in the rejection and in response to Applicant's arguments, due to the unpredictable nature of the claimed invention, the skilled artisan would not be able to ascertain the necessary data to practice the claimed invention without undue experimentation. Applicant's assertion of routine experimentation is not substantiated by any evidence. Furthermore, the attainment of a treatment method for infections is anything but routine. Had it been routine to exploit the Th1 immune response to treat infections, then the virology art would have a vaccine and treatment protocol for all

known infections. In the instant case, it is not routine as Applicant alleged. The art, Infante-Duarte et al. notes that in addition to a Th1 immune response is a double edge sword that needs to be under tight control and balance with a Th2 immune response.

At pages 11-12 of Applicant's response, Applicant argues that the one skilled in the art would recognize the utility of treating viral infection based on the disclosure and data provided by Applicant. To support Applicant's assertion, Applicant cited the teachings of Simpson et al., Schneider et al., Morris et al., and Baumgarth et al.

Applicant's argument has been considered, however, it is not found persuasive. The cited references have also been reconsidered. However, had the Office doubts or question the utility of the claimed invention, a utility rejection would have been issued against the claimed invention. However, in the instant case, the Office issued an enablement rejection. The utility and enablement requirements are distinct from one another.

In addition to above, Applicant also reiterates Applicant's previous arguments, which the Office has addressed in the previous office actions.

As presented in the 03/31/2008 office action, in response to the enablement rejection, Applicant argues that the claimed invention is enabling because the CpG oligonucleotides induce a pattern of immunostimulation that is consistent with viral infection. To substantiate Applicant's arguments, Applicant notes that Applicant have demonstrated in the specification, via working examples, that the oligonucleotides stimulate B cells, natural killer cells and monocytic cells; and production of interferon-gamma, increases the number of spleen cells secrete IL-6, IL-12, IFN-gamma, IFN-

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alpha, IFN-beta, IL-1, IL-3, IL-10, TNF-alpha, TNF-beta, GM-CSF, RANTES; and that an increased in IL-6 expression was found to occur in B-cells, CD4+ T cells and monocyctic cells. To further support Applicant's point, Applicant cited the teachings of Woodworth and Simpson, Schneider, and Morris et al. to demonstrate that one of skilled in the art would recognize that a drug useful for boosting cytokines would be useful in the treatment of papilloma virus.

Applicant's arguments have been considered, however, it not found persuasive. The Office acknowledges the immunostimulatory effects of oligonucleotides containing CpG motifs, however, the issue here is that Applicant has not taught or shown the skilled artisan in the art how to harness the immunostimulatory activities to render it therapeutic in the manner relating to the claimed invention. There is a difference in showing immunostimulatory activities and showing a therapeutic efficacy. As provided in the previous office actions, it is known in the art that these oligonucleotides induce a Th1 biased immune response, which produces Th1 associated cytokines, and that the induction of a Th1 immune response is also important to resolving infections. However, the art also recognizes that a balance between a Th1 and Th2 immune response is of importance in resolving infection, see teachings of Infante-Duarte et al. In the instant case, it is noted that Applicant has not set forth any guidance relating to the maintenance of a Th2 immune response. It appears that Applicant is concerned with is the stimulation of a Th1 biased immune response, yet, Applicant has failed to set forth any guidance as to the type and level of immune profile that the oligonucleotides must ascertain in order to render it therapeutically effective. As mentioned, Applicant has not

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taught the skilled artisan how to harness the immunostimulatory activities in the manner that is consistent with the claimed invention. What is the level of B cell, natural killer cells, monocytic cells, IFN-gamma, IL-6, IL-12, IFN-alpha, IFN-beta, IL-1, IL-3, IL-10, TNF-alpha, TNF-beta, GM-CSF, RANTES; IL-6 expression in B-cells, CD4+ T cells and monocytic cells necessary to treat, prevent and ameliorate papilloma viral infection? Are any of the oligonucleotides taught the specification capable of such activities? As noted in the previous office action, Krieg et al. (Krieg et al. CpG motif in bacterial DNA and their immune effects. *Annu. Rev. Immunol.*, 2002, Vol. 20, 709-760.) advised that each oligonucleotide is distinct from one another for each has a different immune profile. Thus, what is the immune profile required to treat, prevent and ameliorate papilloma viral infection? And what is the sequence of the oligonucleotide that is capable of inducing the required immune profile? In the instant case, Applicant has not provided any answer or guidance to relating to these questions. In the absence of such, Applicant's claimed invention is merely an invitation to experiment. The skilled artisan would have to blindly experiment with every variable encompassed by the claimed invention. And the imposition of blind experimentation would necessarily result in the burden of undue experimentation. Applicant has provided an allegation of enablement based on the ability of the CpG oligonucleotide to induce a Th1 biased immune response. Yet, Applicant has failed to demonstrate anything that commensurate in scope with the claimed invention. The claimed invention is not solely directed at immune stimulation. Instead, the claimed invention is directed at treating, prevent and ameliorating the infection. Hence, while Applicant arguments have been considered, it

is not sufficient to overcome the rejection. It should further be noted that in the years following Applicant's filing of the claimed invention, the art still has not recognize the use of CpG oligonucleotides as an active ingredient in treating, preventing and ameliorating papilloma viral infection. At the very most, the art acknowledges the use of these oligonucleotides as an adjuvant in vaccines. See the teachings of Krieg et al., (Krieg et al. Antiinfective Applications of Toll-Like Receptor 9 Agonists. Proc. Am. Thorac. Soc., Vol. 4, 2007, 289-294.) particularly page 291.

Regarding the teachings of Simpson, Schneider, and Morris et al., these references have been carefully considered, however, contrary to Applicant's assertion, none of these references evidences the use of CpG containing oligonucleotides to treat papilloma virus infection. These references may have been suggestive of a use for a particular cytokine or immunostimulatory activity, however, none of these references set forth the guidance and direction that the skilled artisan would need to practice the claimed invention. None of these references teaches the skilled artisan how to harness the immunostimulatory induced by the oligonucleotides to render it therapeutically effective against papilloma virus infection. These references do not set forth the immune profile, including cytokine production, necessary to treat papilloma virus infection or any oligonucleotide that is capable of inducing the required immune profile. None of these references enable the skilled artisan to practice the claimed invention without undue experimentation.

Additionally, it is noted that Applicant argues that the Office has failed to establish a prima facie case of lack of enablement because the only doubts raised by

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the Office about the enabling nature of claimed invention is related to the lack of predictability and lack of an *in vivo* test of viral infection. This argument has been considered, however, it is not found persuasive. Contrary to Applicant's assertion, the Office has clearly established a *prima facie* case of lack of enablement. In the enablement analysis, the Office clearly followed the Wands factors, the factors used in determining enablement or lack thereof. Applicant is also reminded that the enablement rejection is not made solely on the lack of an *in vivo* test for viral infection. Rather, the enablement rejection, again, is based on the Wands factors as a whole. In the instant case, the absence of an *in vivo* data does not further advance Applicant's assertion of enablement. Moreover, it should be noted that Applicant has not even provided an *in vitro* data demonstrating or evidencing that the CpG oligonucleotides treat, prevent or ameliorate infection. Furthermore, as noted in the previous office action, **the papilloma viral art also notes the failure of oligonucleotides comprising the CpG motif to demonstrate any therapeutic effect on papilloma growth**, as evidenced by Poetker et al.

It is noted that Applicant argues that the administration of cytokines are different from administering a natural component that induces the body to produce a balanced immune response. Applicant argues that a single cytokine may bring to a benefits but it may throw off the balance of other factors leading to problems and side effects. Applicant asserts that the issues of enablement for a CpG oligonucleotide and a cytokine are not the same.

Applicant's arguments have been considered, however, it is not found persuasive. While the issues of enablement for a CpG oligonucleotide and a cytokine are not the same, the issues remain similar. As Applicant asserted, a single cytokine may bring benefits and throw off the balance of other factors leading to problems and side effects. This exact issue remains to be addressed CpG oligonucleotides. In the instant case, the induction of a Th1 biased immune response by these oligonucleotides would necessarily "throw off the balance of other factors leading to problems and side effects". Such factors include Th2 immune response, which is also required for the resolution of infection, as noted by Infante-Duarte et al. As noted throughout this office action, Applicant is reminded that arguments cannot take the place of evidence. If Applicant's claimed invention is enabling as Applicant alleges, the Office invites Applicant to submit data that commensurate in scope with the claimed invention.

It is also noted that Applicant states that the Office is inaccurate when it writes, "At the time the invention was made, it is well known in the art that the CpG motif present in the oligonucleotide stimulates Th1 immune response..." This statement has been noted, however, contrary to Applicant's assertion, the quoted statement is not provided in the instant nor previous office action.

It is further noted that Applicant has reiterates Applicant's previous arguments. The following is directed at those arguments.

As previously noted, in response to the enablement rejection, Applicant argues that the claimed invention is enabling. To support Applicant's arguments, Applicant argues that the specification contains working examples to show the production of

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antibody in response to oligonucleotide stimulation, stimulation of B cells, natural killer cells and monocytic cells, and production of IFN-gamma and other cytokines.

[Examples 2-4, 11, Figures 6, 11 and 15.] Applicant notes that the specification asserts that CpG oligonucleotides are useful in treating viral infections including papilloma virus infection. Applicant further notes that Applicant has provided sufficient direction and guidance in the specification to enable the skilled artisan to practice the claimed invention. Applicant also notes that Applicant have provided preferred modes of administration and formulations. Applicant also disagrees with the Office's position of unpredictability and quantity of experimentation necessary.

Applicant's arguments has been considered, however it is not found persuasive. The Office acknowledges the working examples disclosed in the specification. It is further noted that from this immunostimulatory observation, Applicant asserts that the oligonucleotides are useful in treating various diseases, including papilloma virus infection. However, as Applicant has noted, all that the Office has found is an "assertion" of use rather than any guidance or direction that would enable the skilled artisan to practice the claimed invention without the burden of undue experimentation. In the instant case, Applicant has not disclosed of a single oligonucleotide encompassed by the claimed invention to be therapeutically effective against papilloma virus infection. Nor has Applicant sets forth an immune profile that the oligonucleotide must provide to render it therapeutically effective in the treatment of papilloma virus infection. In the instant case, as noted by Applicant, all Applicant has taught is that the oligonucleotides are immunostimulatory. From this observation, Applicant associated

the immunostimulatory activities to treating papilloma virus infection. However, the association is not substantiated by any evidence demonstrating that the oligonucleotides are therapeutically effective against papilloma virus infection. There is no *in vitro* nor *in vivo* model presented in the specification to evidence that oligonucleotides encompassed by the claimed invention are therapeutic. In the instant case, Applicant has failed to set forth any guidance that would enable the skilled artisan to harness the observed immunostimulatory activity to render a therapeutically effective for the treatment of papilloma virus infection. As noted previously, nothing exists in the specification demonstrating that the fundamental research necessary for the claimed invention has been conducted to support Applicant's assertion of therapeutic efficacy for the oligonucleotides.

While it is noted that a portion of the specification is dedicated to modes of administration and preferred formulation, however, it should be noted that the enablement rejection is not directed at how to administer or formulate the oligonucleotides. The enablement rejection is directed at the failure of the specification to enable the skilled artisan to practice the claimed invention without the burden of undue experimentation. In the instant case, as noted above, Applicant has not evidence that an oligonucleotide is therapeutically effective in the treatment of papilloma virus infection.

It is further noted that Applicant objected to the Office conclusion that all that is present in the specification are conjectures of potential application of such

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oligonucleotides against viral infection, and requested the Office to substantiate this position.

Applicant's objection has been noted, however, the Office stands by this position. In this case, Applicant has not shown or taught that an oligonucleotide comprising the CpG motif has a therapeutic effect against viral infection. All that Applicant has shown is that these oligonucleotides are immunostimulatory, and from these immunostimulatory activities, Applicant asserts that they are useful in the treatment of viral infections. Applicant has not substantiated this assertion by any facts that correlates and commensurate with the claimed invention. As mentioned, the claimed invention is specifically directed at treating, preventing and ameliorating papilloma virus infection. However, Applicant has not taught or provided any guidance directing at the type of immunoparameter that must be modulated, which oligonucleotide has this immunomodulatory activity, and the extent in which the modulation must occur to render a therapeutic effect against papilloma virus infection. All that is present is an assertion of use without any substantiating evidence. Similarly, all that is present are conjectures, reasoning that involve the formation of conclusions from incomplete evidence, of use.

Applicant further submits that much of the art cited in the enablement are not relevant to the current claimed invention. Applicant also asserts that there is no evidence of unpredictability of the invention.

Applicant's submission has been considered, however, it is not found persuasive. It should be noted that the claimed invention is directed at the treatment of papilloma virus infection with the administration of a CpG oligonucleotide. The claimed invention

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is directed at the administration of CpG oligonucleotides to stimulate a Th1 immune response, which induces the production of Th1 associated cytokines. In the instant case, while the claimed invention does not specifically recites the administration of a cytokine, it does relies on the production of a Th1 associated cytokines to render a therapeutic efficacy for a disease. Hence, the cytokine art was introduced in the enablement rejection to demonstrate the level of unpredictability and the quantity of experimentation that would be required of the skilled artisan attempting to practice the claimed invention. In the instant case, the Office relies on the cytokine art to establish that the skilled artisan would not be able to practice the claimed invention without an undue burden of experimentation.

Additionally, these post-filing art evidences that a method of treating papilloma virus infection with the administration of an oligonucleotide comprising the CpG motif has not been ascertained by any skilled artisan in the relevant art.

It is further noted that Applicant criticizes the Office for citing teachings of the cytokine art. Applicant argues that it is not clear how the teachings are relevant to the claimed invention, which is directed at method of treatment for papilloma virus infection with the administration of oligonucleotides.

Applicant's criticisms have been noted, however, because Applicant has disclosed in the specification that the claimed invention relies on the immunostimulatory activities of oligonucleotides comprising CpG motifs to treat papilloma virus infection. Specifically, Applicant disclosure suggests taking advantage of the Th1 biased immune response induced by the oligonucleotides to treat papilloma virus infection. In

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association with a Th1 immune response is the induction of Th1 associated cytokine profiles. The induction of Th1 associated cytokines necessarily follows the production of a Th1 immune response. Hence, the Office cited the teachings of the cytokine arts. These teachings demonstrated that the direct administration of cytokines itself is unpredictable. Hence, if the direct administration of cytokines is unpredictable, it logically follows that the indirect administration of cytokines, via stimulation of a Th1 biased immune response, would necessarily be unpredictable, if not more unpredictable.

In addition to above, Applicant criticizes the Office's interpretation of Krieg and Mutwiri et al. Applicant argues that Office conclusion that the absence of TLR9 in some species would lead to variability in results is misplaced, and notes that Mutwiri et al. discloses that in vitro stimulation of cells by CpG motifs is conserved across species. In response to the Office position that every "oligonucleotide containing the CpG motif must be considered as a separate agent because the quality and type of immune stimulation induced by these oligonucleotides varies...etc.," Applicant argues that Applicant has described a class of oligonucleotides comprising the CpG motif that favors a Th1 immune response, and that variability in the immune response induced by the oligonucleotides should not be the cause for a lack of enablement. Applicant further argues that the statement that the "immunostimulatory activity of CpG oligonucleotides is species specific," does not support a lack of enablement.

Applicant's position has been carefully considered, however, it is not found persuasive. It should be noted that the enablement rejection is not based solely on the

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species specific immunostimulatory activities nor the variability of the immune response induced by oligonucleotides comprising the CpG motifs. The enablement rejection is made on the basis of the Wands factors. A conclusion of lack of enablement means that claimed subject matter was not described in the specification, in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected to use the invention. In this case, the two cited points are directed at the lack of predictability present in the CpG art. The CpG art clearly notes that immunostimulatory activities vary from one species to the next. That is the immunostimulatory activities observed in mice would not necessarily be predictive of the immunostimulatory activities in humans. See Table 1 of Mutwiri et al. The CpG art also clearly cautions that the immune response in each oligonucleotide comprising the CpG motif is distinct from one another. See Krieg et al. (Krieg et al., CpG motif in bacterial DNA and their immune effects. *Annu. Rev. Immunol.*, 2002, Vol. 20, 709-760.) That is, while Applicant has alleged that Applicant has disclosed a class of oligonucleotides that produces a Th1 biased immune response, however, as noted above, the Th1 associated cytokine profile induced by these oligonucleotides is distinct from one another. The existence of variability in the Th1 associated cytokine profile induced by each oligonucleotides comprising the CpG motif, depending on the length of the sequence, the sequences that flanks the CpG motif, the number of CpG motifs...etc., would not enable the skilled artisan to predictably and routinely pick any oligonucleotide comprising the CpG motif, as encompassed by the claims, to treat papilloma virus infection. Additionally, it is noted that Applicant has alleged that the Office' conclusion

that the absence of TLR9 in some species would lead to variability in results is misplaced because Mutwiri et al. discloses that in vitro stimulation of cells by CpG motifs is conserved across species. It appears that Applicant has misconstrued the Office's conclusion. As noted in the previous office action:

- The recognition of the CpG motifs requires Toll-like receptor (TLR) 9, wherein cells that express TLR-9 produce Th1 like proinflammatory cytokines, interferon and chemokines.¹ However, the art also recognizes that TLR-9 is differentially expressed in human mice, and that TLR-9 has not been identified in species other than human and mice.² Thus, with the variability of TLR-9 expression, including absence thereof, the level of a Th-1 immune response would also be variable from one species of animals to the next.

The conclusion noted by the Office is the level of Th1 immune response is also dependent on TLR-9 expression, which varies from one species to the next. Moreover, the Office directs Applicant's attention to Krieg et al.³ Krieg et al. clearly notes that because the cellular patterns of TLR expression varies between different species, the results of TLR stimulation in one species may not be predictive of what will occur in another. Moreover, Mutwiri et al. notes that TLR9 has only been identified in humans and mice. The disclosure of Krieg et al. clearly substantiates the Office's conclusion.

¹ Krieg et al. CpG motif in bacterial DNA and their immune effects. *Annu. Rev. Immunol.*, 2002, Vol. 20, 709-760. [Abstract, in particular.]

² Mutwiri et al. Biological activity of immunostimulatory CpG DNA motifs in domestic animals. *Veterinary Immunology and Immunopathology*, 2003, Vol. 91, 89-103. [See 2nd and 3rd full paragraphs, left column of page 93.]

In is further noted that Applicant notes that the teachings of Infante-Duarte et al. is not inconsistent with the claimed invention. This has been considered, however, it is not sufficient to overcome the rejection. Like the other references, Infante-Duarte et al. fails to enable the skilled artisan how to practice the claimed invention without undue experimentation. While the disclosure of Infante-Duarte may not be "inconsistent" with the claimed invention, but neither the reference nor the instant application teaches the skilled artisan how to harness the Th1 immune response or immunostimulatory activities of CpG oligonucleotides to treat, prevent or ameliorate papilloma virus infection without undue experimentation. Rather than enabling the claimed invention, Infante-Duarte et al. outlines the challenges in harnessing the immune response to resolve intracellular infections.

Regarding the teachings of Equils et al., Agrawal et al. and Olbrich et al., Applicant argues that none of the references teaches the claimed invention. Additionally, it appears that Applicant is arguing that the claimed invention is enabling because Olbrich et al. asserts that "If used under the right conditions, CpG-ODN should be a powerful substance for antiviral therapy in the future. Applicant's arguments have been fully considered, however, it is not found persuasive. Had any of these cited references been enabling for the claimed invention, then the issue of enablement would not have been raised. In the instant case, like Applicant, Olbrich et al. does not teach the skilled artisan how to make and use the claimed invention without undue experimentation for Olbrich et al. does not teach the skilled artisan how to harness the

³ Krieg et al. Antiinfective Applications of Toll-Like Receptor 9 Agonists. Proc. Am. Thorac. Soc., Vol. 4,

immunostimulatory activities to render it therapeutic against papilloma virus infection. However, in the instant case, each of the cited references, which published well after the filing date of the claimed invention, evidences that since the discovery of the immunostimulatory activities of CpG oligonucleotides, the art failed to harness the activities to render it therapeutic against viral infection. Like other arts cited, the references were cited to demonstrate that a high level of unpredictability exists.

In all, while all of Applicant's arguments and criticisms have been carefully considered, the entire submission is not sufficient to overcome the enablement rejection. In this case, Applicant has failed to evidence that the claimed subject matter was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention.

Applicant is reminded that the enablement rejection is made on the basis of the Wands factors. In view of the Wands factors, as established in the previous office action, it is found that the specification is not enabling for the claimed invention. While Applicant may argue that the specification is enabling, the evidence as a whole evidences that Applicant has enabled the skilled artisan to practice the claimed invention without undue experimentation. Applicant has not provided a single working example that is directed at demonstrating that an oligonucleotide comprising the CpG motif is therapeutic against papilloma viral infection, nor any guidance evidencing that said oligonucleotide is indeed therapeutic against papilloma viral infection. This is further exemplified by Applicant's submission, wherein Applicant repeatedly asserted

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that Applicant teaches the use of the oligonucleotide to induce an immune response.

And, Applicant is reminded that this teaching does not commensurate in scope with the claimed invention.

As previously presented, to be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation. In *Genentech Inc. v. Novo Nordisk* 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir. 1997); *In re Wright* 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); See also *Amgen Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1212, 18 USPQ2d 1016, 1026 (Fed. Cir. 1991); *In re Fisher* 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Further, in *In re Wands* 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) the court stated:

Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized by the board in *Ex parte Forman* [230 USPQ 546, 547 (Bd Pat App Int 1986)]. They include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

Breadth of the claims:

The claimed method of treating, preventing or ameliorating papilloma viral infection in a subject with the administration of an oligonucleotide of 8 to 100 nucleotides in length, comprising at least one unmethylated CpG motif and at least one phosphorothioate internucleotide linkage to the subject.

The specification provides the following, A "subject" shall mean human or vertebrate animal including a dog, cat, horse, cow, pig, sheep, goat, chicken, monkey, rat, and mouse. [Lines 31-32, page 19.]

Hence, the breadth of the claims is directed to a method of treating, preventing or ameliorating papilloma viral infection in a subject with the administration of an oligonucleotide comprising at least one unmethylated CpG motif to the subject. The subjects encompassed by the claimed invention are all vertebrate animals, including humans.

Presence or Absence of working examples:

The specification does not contain any working examples that are directed to the claimed invention, a method of treating, preventing or ameliorating papilloma viral infection in a subject with the administration of an oligonucleotide comprising the CpG motif. The specification does not containing any working examples demonstrating that such oligonucleotides treat, prevent or ameliorate any viral infection. Nothing exists in the specification demonstrating that fundamental research has been conducted to support Applicant's claimed invention, wherein oligonucleotides comprising the CpG motif treat, prevent or ameliorate viral infection, including papilloma viral infection.

Amount of direction or guidance present in the specification:

The specification **only refers to papilloma virus once, line 21, page 14.** Beside this single reference to the virus, the specification does not contain any teachings relating to the virus. In the instant, the specification does not set forth any evidence demonstrating that oligonucleotides containing the CpG motif treat, prevent or

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ameliorate viral infection. All that is present in the specification are conjectures of potential application of such oligonucleotides in the treatment, prevention and amelioration of viral infections in vertebrate subjects. However, none of these conjectures are substantiated by any evidence.

Nature of the invention

Based on Applicant's disclosure, it appears that the nature of the claimed invention is directed to the use of the art recognized immunostimulatory activity of oligonucleotides containing the CpG motif, including the induction of Th1 immune response invoked by the production of Th1 associated cytokines, accorded by the CpG motif, to render a therapeutic value, wherein the desired therapeutic value is to provide treatment, prevention and amelioration of papilloma viral infection in vertebrate subject--immunotherapy.

State of the Art:

In the instant, the involvement of a Th1 type immune response in combating against intracellular pathogens is a well-recognized general concept. The art acknowledges the importance of Th1 type immune response, which is stimulated by the production of Th1 associated cytokines, in the elimination of intracellular pathogens, including viruses. However, the art has not accredited or recognized any one particular Th1-associated cytokine to the treatment, prevention and amelioration of viral infection in a subject. Specifically, the art teaches that while cytokines secreted by T helper cells are of critical importance for the outcome of many infectious diseases, the production of the "right" set of cytokines can be a matter of life or death, as noted by Infante-Duarte et

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al. Infante-Duarte et al. further notes that in addition to a Th1 type immune response, a Th2 type immune response is also necessary. Specifically, Infante-Duarte et al. teaches that a tight control over where and when Th1 and Th2 immune responses happen is necessary to keep intracellular infections under control, and to prevent the Th1 type immune response from causing damage to the host.⁴ Hence, while the importance of a Th1 type immune response is well recognized in the art, the art further notes that a balance between Th1 and Th2 type immune responses is necessary to resolve an infection.

The cytokine art also provides that the efficacy of Th1 associated cytokines, such as interleukin 2, interleukin 12 and interleukin 18, against intracellular pathogens are controversial, as evidenced by Aoki et al.,⁵ Bohn et al.,⁶ Sakao et al.,⁷ Zaitseva et al.,⁸ and Masihi, K.⁹ Aoki et al. teaches that while interleukin 2 may confer good protection for non-pathogenic mycobacterial strain Bacille Calmette-Guerin (BCG), interleukin 2 does not confer protection for virulent *M. bovis* infection. Bohn et al. teaches that interleukin-12, a Th1 associated cytokine, induces different effector mechanisms that result in either protection or exacerbation of a disease. Specifically, Bohn et al. notes that the administration of exogenous interleukin 12 confers protection against *Yersinia*

⁴ Infante-Duarte et al., Th1/Th2 balance in infection. Springer Seminars in Immunopathology, 1999, 21: 317-338. [Paragraph bridging pages 321-322, in particular.]

⁵ Aoki et al. Use of cytokines in infection. Expert Opin. Emerg. Drugs, 2004, vol. 9, No. 2, 223-236. [Lines 4-15, left column, page 229, in particular]

⁶ Bohn et al., Ambiguous role of interleukin-12 in *Yersinia enterocolitica* infection in susceptible and resistant mouse strains. Infect. Immune., 1998, Vol. 66, 2213-2220. [Abstract, in particular.]

⁷ Sakao et al. IL-18-deficient mice are resistant to endotoxin-induced liver injury but highly susceptible to endotoxin shock. Int. Immunol., 1999, Vol. 11, 471-480. [Abstract, in particular.]

⁸ Zaitseva et al. Interferon gamma and interleukin 6 modulate the susceptibility of macrophages to human immunodeficiency virus type 1 infection. Blood, 2000, Vol. 96, 3109-3117. [Abstract, in particular]

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enterocolitica in susceptible BALB/c mice, but exacerbates yersiniosis in resistant C57BL/6 mice. Sakao et al. teaches that interleukin 18, a Th1 associated cytokine, is responsible for the progression of endotoxin-induced liver injury in mice primed with interleukin 18. Zaitseva et al. teaches that both interleukin 6 and interferon gamma augment the susceptibility of monocyte-derived macrophages to infection. Masihi, K. notes that interleukin 2 increases the production of HIV in vitro, and enhances the translocation of bacteria from intestines to other organs in animal studies. In summation, the art teaches that cytokines can be inherently toxic, have unclear pharmacological behavior and also have pleiotropic effects. Hence, the art recognizes that the use of cytokine to direct treatment is unpredictable and complicated.

Additionally, while the art teaches that oligonucleotides containing the CpG motif are capable of stimulating a Th1 type immune response, however, the art also teaches that the Th1 associated cytokine profile for these oligonucleotides vary from one oligonucleotide and species of subject to the next, as evidenced by Krieg et al.¹⁰ and Mutwiri et al.¹¹ Krieg et al notes that each oligonucleotide containing the CpG motif must be considered as a separate agent because the quality and type of immune stimulation induced by these oligonucleotides varies. Krieg et al. particularly notes that the type of cytokine stimulated by oligonucleotides containing the CpG motif is distinct from one oligonucleotide to the next. Additionally, both Krieg et al. and Mutwiri et al.

⁹ Masihi, K. Fighting infection using immunomodulatory agents. *Expert Opin. Biol. Ther.*, 2001, Vol. 1, No. 4, 641-653. [Lines 15-25, left column of page 646, in particular]

¹⁰ Krieg et al., CpG motif in bacterial DNA and their immune effects. *Annu. Rev. Immunol.*, 2002, Vol. 20, 709-760. [paragraph that bridge pages 716-717, in particular.]

note that the level and type of immune stimulation varies depending on i) the specific nucleic acids, purines and pyrimidines, surrounding the CpG motif; ii) the spacings between CpG motifs; iii) the numbers of CpG motifs in an oligonucleotide; iv) the absence or presence of a CpG motif to the end of the oligonucleotide; and v) the context in which the CpG motif is presented in the sequence.

The CpG art further teaches that the immunostimulatory activity of oligonucleotides containing the CpG is very species specific, as evidenced by Mutwiri et al. Table 1 of Mutwiri et al. provides that the *in vitro* immunostimulatory activity of oligonucleotides containing the CpG motif varies from one species to the next. Mutwiri et al. also notes that the level of immunostimulating induced by a particular oligonucleotide is also dependent on the sequence(s) flanking the CpG motif. Specifically, Mutwiri et al. notes that the GTCGTT motif, which is the optimal motif for humans, is optimal for stimulation of lymphocyte proliferation in several species including cattle, sheep, goats, horses, pigs, dogs, cats and chickens; whereas the murine CpG motif (GACGTT) is only optimal for inbred rabbits and mice.

Furthermore, both Krieg et al. and Mutwiri et al. sets forth that the recognition of the CpG motifs requires Toll-like receptor (TLR) 9, wherein cells that express TLR-9 produce Th1 associated cytokines. However, Mutwiri et al. provides that TLR-9 has only been identified in mice and humans. Mutwiri et al. also provides that the TLR-9 is differentially expressed in humans and mice. Hence, if the recognition of the CpG motif were dependent of TLR-9, then it would logically follows that the extent of the Th1 type

¹¹ Mutwiri et al. Biological activity of immunostimulatory CpG DNA motifs in domestic animals. Veterinary Immunology and Immunopathology, 2003, Vol. 91, 89-103. [See 2nd and 3rd full paragraphs, left column of page 93;

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immune response induced by the oligonucleotide would necessarily vary from one species to the next. Mutwiri et al. also sets forth that *in vitro* observations do not accurately predict what happens *in vivo*.

Moreover, the potential use of oligonucleotides containing the CpG motif to stimulate a Th1 type immune response that treats and prevents infection is widely speculated in the art. However, efforts to harness the immunostimulatory activity of oligonucleotides containing the CpG motif to trigger an innate immune response that protect a host from infectious pathogen has proven to be challenging and elusive, as evidenced by Yamamoto et al.,¹² Equils et al.,¹³ Agrawal et al.,¹⁴ and Olbrich et al.¹⁵ Yamamoto et al. reports that oligonucleotides containing the CpG motif failed to improve the survival in mice challenged with influenza. Equils et al. teaches that such oligonucleotides can induce the HIV transcriptional regulatory elements in long terminal repeats, increasing viral replication. Agrawal et al. teaches that HIV-infected humans treated with oligonucleotides containing the CpG motif showed dose-dependent increases viral load. Lastly, Olbrich et al. teaches that the administration of oligonucleotides containing the CpG motif accelerated and increased the severity of Friend retrovirus in mice. In the case of Olbrich et al., the author notes that the use of oligonucleotides containing the CpG motif for the treatment of viral infection may be a

last sentence of paragraph bridging pages 89-90.]

¹² Yamamoto et al., Oligodeoxyribonucleotides with 5'ACGT-3' or 5TCGA-3 sequence induce production of interferons. *Curr. Top. Microbiol. Immunol.* 2000, Vol. 247, 23-40.

¹³ Equils et al. Toll-like receptor 2 (TLR2) and TLR9 signaling resulted from HIV-long terminal repeat transactivation and HIV replication in HIV-1 transgenic mouse spleen cells: implications of simultaneous activation of TLRs on HIV replication. *J. Immunol.* 2003, 170, 5159-5164.

¹⁴ Agrawal, et al. Was induction of HIV1 through TLR9? *J. Immunol.* 2003, 171, 1621-1621.

¹⁵ Olbrich et al. Preinfection treatment of resistant mice with CpG oligodeoxynucleotides renders them susceptible to friend retrovirus-induced leukemia. *J. Virol.*, 2003, 77, 10658-10662.

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double edge sword that can resolute in effective therapy but also in acceleration of disease. Olbrich et al. notes that this double edge sword observation may be dependent on the time point of treatment.

Hence, overall, the literature notes the use of CpG to stimulate the production of cytokines, the use of cytokines to influence viral infection, and the development of a treatment regimen for diseases is unpredictable and complicated.

Additionally, the papilloma viral art also notes the failure of oligonucleotides comprising the CpG motif to demonstrate any therapeutic effect on papilloma growth, as evidenced by Poetker et al.¹⁶ Poetker et al. also notes that the lack of a therapeutic effect by the oligonucleotide suggests that either enhanced papilloma antigen presentation or targeting of immune evasive mechanisms used by the papillomas is needed to treat bulky disease with an immunotherapeutic strategy. And Poetker et al. further notes that such mechanism will need to be addressed if immunotherapeutic strategies are to be rationally and successfully applied. In the instant, while the claimed invention utilizes immunotherapeutic approach, it is noted that the immunotherapeutic strategy does not include an enhanced papilloma antigen presentation or targeting of immune evasive mechanisms used by the papillomas. None of these factors are present in the claimed invention.

Predictability or unpredictability of the art:

As discussed above, the art recognizes that the use of cytokine to direct treatment is unpredictable and complicated. The art also recognizes that use of CpG to

stimulate cytokine production, the use of the induced cytokine to influence viral infection, and the development of treatment regimen unpredictable and complicated. The art additionally teaches that the efforts to harness the immunostimulatory activity of oligonucleotides containing the CpG motif to trigger an innate immune response that protect a host from infectious pathogen has proven to be challenging and elusive.

Quantity of experimentation necessary:

Extreme undue burden of experimentation would be imposed upon the skilled artisan practicing the claimed invention. As stated above, Applicant has not provided much, if any, guidance or direction relating to the claimed invention. All that Applicant has provided is a conclusion that is made on the basis of generalized concepts that are well known in the art. And the formation of a conclusion based on generalized concepts renders the conclusion flawed. Generalized concepts are directed to support a general direction of studies or research; however, they do not support concrete conclusions. Concrete conclusions must be substantiated by facts, including evidence. In the instant, while the general direction of research may be outlined for the skilled artisan, the skilled artisan would not readily be able to practice the claimed invention without the undue burden of experimentation. The path that the skilled artisan must take in his research is marked with many challenges that are recognized in the art, including the complex nature of oligonucleotides containing CpG motif and the complexity of the immune system, including the Th1 type immune response and the functional characteristics of its associated cytokines. Hence, in view of the lack of any guidance in the specification

¹⁶ Poetker et al. Immune Stimulation for the treatment of papilloma. *Annals of Otolaryngology &*

concerning the effective use of oligonucleotides to treat, prevent or ameliorate viral infection in a subject; the unpredictability of oligonucleotides containing CpG motif to stimulate specific immune response; and the inherent toxicity, the unclear pharmacological behavior, and the pleiotropic effects of cytokines; the skilled artisan would not be able to reasonably practice the claimed invention without an undue burden experimentation. Thus, the claims are rejected under 35 U.S.C § 112, 1st paragraph for failing to comply with the enablement requirement.

A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F. 2d 1557, 1562, 27 USPQ 2d 1510, 1513 (Fed. Cir. 1993).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. The provisional obviousness-type double patenting rejections of the claims over 10/987146, 11/255100 and 11/361313 are withdrawn in view of Applicant's submission.
7. Claims 42-43, 47-51, 55-58 and 62-74 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 42, of copending Application No. 10/382822.

In response to the rejection, Applicant elects to defer substantive rebuttal until the application is allowed.

Applicant's election has been considered, however, until the provisional obviousness-type double patenting rejection is properly addressed, the rejection is maintained on the record.

The claimed invention is directed toward a method of treating, preventing and ameliorating papilloma viral infection with the administration of an oligonucleotide comprising at least one unmethylated CpG motif to a subject having papilloma viral infection.

Claim 42 of the conflicting patent application is directed at a method of treating, preventing and ameliorating viral infection in a subject with the administration of an oligonucleotide comprising the CpG.

The difference between the claims is: claim 42 of the conflicting patent application is not limited to the treatment of papilloma viral infection in a subject. However, paragraph 49 of the conflicting patent application's PreGrant publication provides papilloma viral infection as a viral infection. Hence, by viral infection, claim 42 of the conflicting patent application also encompasses papilloma viral infection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Some of the above rejections are, in part, based on the specification of the conflicting patent application, rather than the claims. In support of the use of this material, the examiner notes the following excerpt from MPEP section 804 II(B)(1):

When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. This does not mean that one is precluded from all use of the patent disclosure.

The specification can always be used as a dictionary to learn the meaning of a term in the patent claim. In *re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. In *re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). The court in *Vogel* recognized "that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim," but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim. According to the court, one must first "determine how much of the patent disclosure pertains to the invention claimed in the patent" because only "[t]his portion of the specification supports the patent claims and may be considered." The court pointed out that "this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103, since only the disclosure of the invention claimed in the patent may be examined."

Thus, the courts have held that it is permissible to use the specification in determining what is included in, and obvious from, the invention defined by the claim on which the rejection is based. This is true even where elements are drawn from the specification describing the claimed invention which are not elements in the claim itself.

Conclusion

8. No claims are allowed.

9. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **EMILY M. LE** whose telephone number is (571)272-0903. The examiner can normally be reached on **Monday - Friday, 8 am - 5:30 pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Bruce R. Campell** can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/EMILY M LE/
Primary Examiner, Art Unit 1648

/E. L./